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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/153,577 09/15/98 ZIGMOND D 3382-50875/S

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EXAMINER

PEYTON, T	
ART UNIT	PAPER NUMBER

2782
DATE MAILED: 04/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

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Office Action Summary

Application No.

09/153,577

Applicant(s)

ZIGMOND ET AL.

Examiner

Tammara Peyton

Group Art Unit

2782

☒ Responsive to communication(s) filed on Sep 15, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) 1-5, 17, and 18 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 6-16 and 19-24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-5, 17, and 18 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. Claims 1-24 are pending for application 09/153,577 filed on 09/15/98.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 1-5 draw to a claimed invention of a reducing the size of the displayed television signal while displaying a page of auxiliary data is classified in Class 348, subclass 568.

Group II: Claims 6-16, 19-24 draw to a claimed invention of displaying a television signal with an icon associated with a user interface classified in Class 348, subclass 564 or Class 710, subclass 1.

Group III: Claims 17-18 draw to a claimed invention of displaying a television except with additional information classified in Class 348, subclass 563.

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Groups I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable because of the following reasons:

- A. the search required for Group I is not required for the Group II or III;
 the search required for Group II is not required for the Group I or III;
 the search required for Group III is not required for the Group I or II;
- B. the invention of Group I can be used independently of the invention of Group II and III;
the invention of Group II and III can be used independently of the invention of Group I.
 the invention of Group II can be used independently of the invention of Group I and III;
the invention of Group I and III can be used independently of the invention of Group II.
 the invention of Group III can be used independently of the invention of Group I and II;
the invention of Group I and II can be used independently of the invention of Group III. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Stephen A. Wight, Reg. No. 37,759, on April 18, 2000 a provisional election was made without traverse to prosecute the invention of Group II,

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claims 6-16, 19-24. Affirmation of this election must be made by applicant in responding to this Office Action. Claims 1-5, 17-18 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless.--

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 6, 11-12 are rejected under 35 U.S.C. 102(e) as being unpatentable by *Bedard*, patent no. 5,801,747.

7. As per claim 6, *Bedard* teaches a method of operating a screen used to display both television signals and screens of auxiliary data [see Fig. 5], comprising:

displaying a television signal; and

displaying with the display television signal an icon, said icon indicating the availability of an associated screen of auxiliary data. [Note Abstract, *Bedard*, col. 2, lines 13-22, col. 7, lines 28-64, and col. 8, lines 23 - col. 9, lines 1-3]

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8. As per claims 11 and 12, *Bedard* inherently includes triggering display of said icon at a predetermined time of day depending on the individual viewer's profile and whenever something of interest available during a particular broadcast the viewer is currently watching.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bedard*, patent no. 5,801,747 and *Portuesi*, patent no. 5,774,666.

11. As per claim 7, *Bedard* teaches the method of displaying with a television signal an display icon but does not teach a method which includes displaying said icon for a predetermined period, and thereafter removing the displaying icon from the screen. However, *Portuesi* teaches a method of displaying with a television/video signal an display icon [[hypertext link](#), 32, Fig. 3], for a predetermined period, and thereafter removing the displaying icon from the screen. One of

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ordinary skill would readily recognize that the hypertext link taught by *Portuesi* could be replaced by a picture icon and not depart from its inventive concept because an icon in itself is a hypertext link. [*Portuesi*, col. 5, lines 66-col. 6, lines 1-14, col. 8, lines 53- col. 9, lines 1- 43]

12. *Portuesi* is directed toward video programming and *Bedard's* is directed towards television programming, wherein *Portuesi's* and *Bedard's* systems are configured to receive television signals that are subsequently decoded to be viewed by user. It would have been obvious for one of ordinary skill to realize both systems draw to displaying an icon associated with the current program, wherein if the icon is selected, display information related to said program. By adding *Portuesi's* limitation of displaying said icon for a predetermined period expands and adds flexibility to *Bedard's* system by not inhibiting the viewer's program by continuously displaying said icon throughout the telecast.

13. As per claim 8, which further includes displaying said icon in response to data conveyed with the television signal. *Portuesi* teaches of displaying the hypertext link icon that corresponds to the current television signal being displayed. [*Portuesi*, col. 5, lines 66-col. 6, lines 1-14]

14. As per claims 9 and 10, *Portuesi* teaches a method of displaying an icon for a predetermined period of time it would have been obvious for one of ordinary skill that *Portuesi* would also teach a code to implement the method. [*Portuesi*, col. 5, lines 66-col. 6, lines 1-14]

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15. Claims 16 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bedard*, patent no. 5,801,747.

16. As per claim 16, it would have been obvious to one of ordinary skill that *Bedard's* system teaches a method of operating a screen to display both television programming and an user information interface. [Fig. 5] *Bedard* discloses of displaying a small icon advertising, on the television screen while displaying a television program, information available from the web associated with the current television program being watched. Specifically, when a viewer depresses the icon "CNN" information about the current programming would appear. [508, Fig. 5] It would have been obvious for one of ordinary skill that in response to the user depressing the small icon an user information interface with additional information relating to site and its contents would also appear. One of ordinary skill would readily recognize said icon could be linked to a plurality of predefined information messages specifically an advertising message and not depart from its inventive concept.

17. As per claims 19, it would have been obvious to one of ordinary skill that *Bedard's* system teaches a method of operating a screen to display both television programming and an user information interface. [Fig. 5] *Bedard* discloses of displaying a small icon, on the television screen while displaying a television program, related to information available from the web

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associated with the current television program being watched. Specifically, when a viewer depresses the icon "CNN" information about the current programming would appear. [508, Fig. 5] It would have been obvious for one of ordinary skill to realize that by depressing the small icon an user information interface about the site and its contents would also appear. Further, one of ordinary skill would readily recognize that *Bedard* would superimposed the small icon on the television screen in order to not inhibit the viewer's television program.

18. As per claim 20, it would have been obvious for one of ordinary skill to realize that by depressing the small icon superimposed over the television screen during a current program the viewer is watching, an user information interface would appearance in order to display information from the Internet site and its contents. Therefore, it would also be obvious that *Bedard* teaches a method wherein the user information interface [502, 508 of Fig. 5] is formed by changing the luminance of the display television programming to display said user information interface.

19. Claims 13-15 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bedard*, patent no. 5,801,747 and *Portuesi*, patent no. 5,774,666.

20. As per claims 13-15 and 21, *Bedard* teaches a method of operating a screen used to display both television programming and pages of supplementary image data, comprising:

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displaying the television programming on the screen;
alerting a viewer [via a small icon] to the availability of a page of supplementary image data associated with said displaying television programming;
receiving a signal from the viewer indicating an interest in the supplementary image data;
responsive to said indication of viewer interest, displaying textual data related to said page of supplementary image data; [if the viewer depresses the small icon it would have been obvious for one of ordinary skill to realize that an user information interface about the site and its contents would also appear]

However, *Bedard* does not expressly teaches of receiving a further signal from the viewer indicating a continued interest in the supplementary image data and responsive to said further indication of viewer interest, displaying said page of supplementary image data.

21. Nonetheless, *Portuesi* teaches displaying a television/video program that alerts a viewer using a hypertext link to the availability of a page of supplementary image data associated with the current program. In response from the viewer indicating a continued interest in the supplementary image data [by positioning the mouse over the hypertext link thereby highlighting it] and responsive to said further indication of viewer interest [by clicking via the mouse the now highlighted hypertext link], displaying said page of supplementary image data. [*Portuesi*, col. 5, lines 66-col. 6, lines 1-27, col. 8, lines 53- col. 9, lines 1- 43]

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22. *Portuesi* is directed toward video programming and *Bedard's* is directed towards television programming, wherein *Portuesi's* and *Bedard's* systems are configured to receive television signals that are subsequently decoded to be viewed by user. It would have been obvious for one of ordinary skill to realize both systems draw to displaying an icon during a particular telecast and alerting the viewer to the availability of a page of supplementary image data associated with the current program, wherein if the icon is selected by the viewer display information related to said program.

23. One of ordinary skill would readily recognize that by adding the limitation of indicating a continued interest in the supplementary image data and responsive to said further indication of viewer interest, displaying said page of supplementary image data as taught by *Portuesi* would expand and add flexibility to *Bedard's* system by giving the viewer the opportunity to gather more information related to the current program via the Internet.

24. As per claim 22, *Bedard* teaches a method which includes displaying said textual data in conjunction with display of said television programming. [See Fig.5]

25. As per claim 23, *Portuesi* teaches a method which includes displaying an user information interface with said textual data, the user interface permitting the viewer to signal said further interest in viewing the supplementary image data.[Fig.3]

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26. As per claim 24, *Portuesi* teaches a method which includes replacing display of the television/video programming with display of said supplementary image data. [*Portuesi*, col. 8, lines 53- col. 9, lines 1- 43]

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703) 306-5508. The examiner can normally be reached between 8:00 - 4:30 from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Lee, can be reached on (703) 305-9717. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

28. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks

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Washington, D.C. 20231.

Faxes for formal communications intended for entry should be sent to:

(703) 308-9051,

or, for informal or draft communications, to:

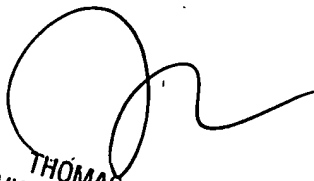
(703) 306-5404 (please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Tammara Peyton

April 20, 2000



THOMAS C. LEE
SUPERVISORY PATENT EXAMINER
GROUP 2700